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| 09/821,134      | 03/29/2001  | Maria A. Himmel      | AUS9-2001-0190-US1  | 5631             |

7590 01/20/2004

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EXAMINER

CHO, UN C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2682

DATE MAILED: 01/20/2004

3

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/821,134

Applicant(s)

HIMMEL ET AL.

Examiner

Un C Cho

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11-21, 23, 25-35, 37 and 39-42 is/are rejected.
- 7) ☒ Claim(s) 8, 10, 22, 24, 36, 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

## DETAILED ACTION

### *Information Disclosure Statement*

1. The IDS filed 3/29/2001 has been considered and recorded in the file.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1 – 4, 7, 9, 11 – 13, 15 – 18, 21, 23, 25 – 27, 29 – 32, 35, 37, 39 - 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagi (US 2001/0018340) in view of Hendrey et al. (US 6,647,269).

Regarding Claim 1, Tagi teaches detecting a registration of the terminal with a base station and transmitting the advertisement to the terminal (Tagi, Paragraph 0033 and Paragraph 0034, lines 1 - 6). However, Tagi fails to teach initiating a user preferred schedule for transmitting advertisements to the mobile station and transmitting the advertisement to the mobile station in accordance with the user preferred schedule. In contrast, Hendrey teaches initiating a user associated profile for transmitting advertisements to the mobile station (Hendrey, Col. 4, lines 35 – 41). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of

Hendrey to Tagi to provide a service of sending advertising messages or coupons to mobile units based on the mobile unit's location and further analyzing the effectiveness of the sent advertisement.

Regarding claim 2, Tagi teaches verifying a reception of the advertisement by the terminal in response to a reception of further pressing the advertisement key (Fig. 13, 14d) from the terminal that indicates a reception of the advertisement by the terminal (Paragraph 0083, lines 1 – 5).

Regarding claim 3, Tagi teaches rewarding a user of the terminal in response to a responsive command from the terminal that indicates a reception of the advertisement by the terminal (Paragraph 0082, lines 6 - 12).

Regarding claim 4, Tagi teaches notification between the terminal and the advertisement server associated with an advertiser represented in the advertisement in response to a reception of a pressing of the advertisement key (Fig. 13, 14d) indicating a desire of a user of the terminal to confirm the advertisement notification (Paragraph 0083, lines 1 – 13).

Regarding claim 7, Tagi teaches determining a location of the terminal (Paragraph 0058, lines 1 – 4). However, Tagi fails to teach matching a location of an advertiser represented in the advertisement with the location of the mobile station. In contrast, Hendrey teaches matching a location of an advertiser represented in the advertisement with the location of the user (Col. 4, lines 31 – 35). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Hendrey to Tagi to

provide a service of sending advertising messages or coupons to mobile units based on the mobile unit's location and further analyzing the effectiveness of the sent advertisement.

Regarding claim 9, Tagi fails to teach retrieving a user profile corresponding to the mobile station and matching a good or a service represented in the advertisement with the user profile. However, Hendrey teaches retrieving a user profile corresponding to the user and matching goods represented in the advertisement with the user profile (Col. 4, lines 35 – 40). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Hendrey to Tagi to provide a service of sending advertising messages or coupons to mobile units based on the mobile unit's location and further analyzing the effectiveness of the sent advertisement.

Regarding claim 11, Tagi teaches transmitting an advertisement to the terminal subsequent to a registration of the terminal with a base station (Tagi, Paragraph 0033 and Paragraph 0034, lines 1 – 6) and verifying a reception of the advertisement by the terminal in response to a reception of further pressing the advertisement key (Fig. 13, 14d) from the terminal that indicates a reception of the advertisement by the terminal (Paragraph 0083, lines 1 – 5).

Regarding claim 12, the claim is interpreted and rejected for the same reason as set forth in claim 3.

Regarding claim 13, the claim is interpreted and rejected for the same reason as set forth in claim 4.

Regarding claim 15, the claim is interpreted and rejected for the same reason as set forth in claim 1.

Regarding claim 16, the claim is interpreted and rejected for the same reason as set forth in claim 2.

Regarding claim 17, Tagi teaches transmitting a responsive command in response to a reception of the advertisement by further pressing the advertisement key (Fig. 13, 14d) (Paragraph 0083, lines 1 – 5) and rewarding a user of said terminal in response to said responsive command from said mobile terminal (Paragraph 0082, lines 6 – 12).

Regarding claim 18, Tagi teaches transmitting a responsive command in response to a reception of the advertisement by further pressing the advertisement key (Fig. 13, 14d) (Paragraph 0083, lines 1 – 5) and establishing a notification between the terminal and the advertisement server associated with an advertiser represented in the advertisement in response to a reception of a pressing of the advertisement key (Fig. 13, 14d) indicating a desire of a user of the terminal to confirm the advertisement notification (Paragraph 0083, lines 1 – 13).

Regarding claim 21, the claim is interpreted and rejected for the same reason as set forth in claim 7.

Regarding claim 23, the claim is interpreted and rejected for the same reason as set forth in claim 9.

Regarding claim 25, the claim is interpreted and rejected for the same reason as set forth in claim 11.

Regarding claim 26, the claim is interpreted and rejected for the same reason as set forth in claim 3.

Regarding claim 27, the claim is interpreted and rejected for the same reason as set forth in claim 4.

Regarding claim 29, the claim is interpreted and rejected for the same reason as set forth in claim 1.

Regarding claim 30, the claim is interpreted and rejected for the same reason as set forth in claim 2.

Regarding claim 31, the claim is interpreted and rejected for the same reason as set forth in claim 3.

Regarding claim 32, the claim is interpreted and rejected for the same reason as set forth in claim 4.

Regarding claim 35, the claim is interpreted and rejected for the same reason as set forth in claim 7.

Regarding claim 37, the claim is interpreted and rejected for the same reason as set forth in claim 9.

Regarding claim 39, the claim is interpreted and rejected for the same reason as set forth in claim 15.

Regarding claim 40, the claim is interpreted and rejected for the same reason as set forth in claim 3.

Regarding claim 41, the claim is interpreted and rejected for the same reason as set forth in claim 4.

4. Claim 5, 6, 14, 19, 20, 28, 33, 34 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tagi and Hendrey as applied to claim 1 above, and further in view of Kim (US 2003/0050837).

Regarding claim 5, Tagi as modified by Hendrey teaches rewarding a user of the terminal when there the terminal notifies the advertising server (Paragraph 0077, lines 3 – 7 and Paragraph 0082, lines 6 – 12). However, Tagi as modified by Hendrey fails to teach rewarding a user of the mobile station when an establishment of the communication link results in a purchase of a good or a service from the advertiser. In contrast, Kim teaches rewarding a user after a purchase of a corresponding advertisement product (Kim, Paragraph 0037, lines 16 – 22). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Kim to Tagi and Hendrey to provide a method in providing an advertisement using a tone of ringing sounds of a mobile phone terminal and a commercial transaction service in association with the same.

Regarding claim 6, Tagi as modified by Hendrey fails to teach providing a credit to an account of the user of the mobile station when transmitting the



advertisement to the mobile station. However, Kim teaches providing a refund to an account of the user of the mobile phone in return to an advertisement listening or watching (Paragraph 0037, lines 11 – 13). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Kim to Tagi and Hendrey to provide a method in providing an advertisement using a tone of ringing sounds of a mobile phone terminal and a commercial transaction service in association with the same.

Regarding claim 14, the claim is interpreted and rejected for the same reason as set forth in claim 5.

Regarding claim 19, the claim is interpreted and rejected for the same reason as set forth in claim 5.

Regarding claim 20, the claim is interpreted and rejected for the same reason as set forth in claim 6.

Regarding claim 28, the claim is interpreted and rejected for the same reason as set forth in claim 5.

Regarding claim 33, the claim is interpreted and rejected for the same reason as set forth in claim 5.

Regarding claim 34, the claim is interpreted and rejected for the same reason as set forth in claim 6.

Regarding claim 42, the claim is interpreted and rejected for the same reason as set forth in claim 5.

***Allowable Subject Matter***

1. Claim 8, 10, 22, 24, 36 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reason for allowance:

Regarding claim 8, Tagi (US 2001/0018340) and Hendrey et al. (US 6,647,269), either alone or combination fail to teach determining a first service area base station; determining a second service area of any potential handoff base station; and matching a location of an advertiser represented in the advertisement with the first service area or the second service area.

Regarding claim 10, Tagi (US 2001/0018340) and Hendrey et al. (US 6,647,269), either alone or combination fail to teach compiling a list of advertisements previously transmitted to mobile station prior to transmitting the advertisement to the mobile station and transmitting the advertisement that is absent from the list.

Regarding claim 22, the claim is interpreted and objected for the same reason as set forth in claim 8.

Regarding claim 24, the claim is interpreted and objected for the same reason as set forth in claim 10.

Regarding claim 36, the claim is interpreted and objected for the same reason as set forth in claim 8.

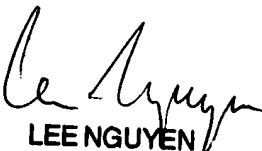
Regarding claim 38, the claim is interpreted and objected for the same reason as set forth in claim 10.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Un C Cho whose telephone number is (703)305-8725. The examiner can normally be reached on M ~ F 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703)308-6739. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Un C Cho *UC*  
Examiner  
Art Unit 2682

  
LEE NGUYEN  
PRIMARY EXAMINER *1/7/04*